

II. Translation of Wataru

More accurate translations of paragraphs [0005], [0006], [0018]-[0020] and [0024] of Wataru are attached hereto for the Examiner's convenience.

III. Claims 1-3, 15 & 18 Satisfy the Requirements of 35 U.S.C. §112, 2nd Paragraph

The Office Action rejects claims 1-3, 15 and 18 under 35 U.S.C. §112, second paragraph for being indefinite. This rejection is respectfully traversed.

Specifically, the Office Action asserts that claims 1, 15 and 18 do not state the conditions on which the prohibition of operation is cancelled. This assertion is respectfully traversed.

As agreed upon during the personal interview, claims 1-3, 15 and 18 satisfy the requirements of 35 U.S.C. §112, second paragraph. Independent claims 1, 15 and 18 recite that prohibition of operation is cancelled "if a predetermined time period has elapsed since the prohibition against the selective operation of one of the plurality of dummy switches." According to this construction, if a predetermined time period has elapsed since nullification of operation, the nullification is canceled. Thus, the operator can continue to operate, for example, without stopping the vehicle (see pg. 6, lines 16-25 of the specification). Support for this feature can also be found in the specification at least at Fig. 2 (Ref. 230) and the corresponding description. Therefore, one of ordinary skill in the art would readily understand claims 1, 15 and 18.

Thus, for at least these reasons, claims 1, 15 and 18 satisfy the requirements of 35 U.S.C. §112, second paragraph. Further, claims 2 and 3, which depend from claim 1, also satisfy the requirements of 35 U.S.C. §112, second paragraph, for at least the reasons discussed above with respect to claim 1. Withdrawal of the rejection is thus respectfully requested.

IV. Claims 1-7, 15, 16, 18 and 19 Define Patentable Subject Matter

The Office Action rejects claims 1-7, 15, 16, 18 and 19 under 35 U.S.C. §103(a) over JP Publication No. 11-198745 to Wataru et al. (Wataru). This rejection is respectfully traversed.

As agreed during the personal interview, claims 1-7, 15, 16, 18 and 19 would not have been rendered obvious by Wataru. As acknowledged by the Office Action, Wataru does not disclose an operation nullification canceller or an operation nullification cancel means "that cancels prohibition against the inputting of the predetermined operation performed by the operator as the operator guidance if a predetermined period of time has elapsed since the prohibition against the inputting of the predetermined operation performed by the operator as the operator guidance," as recited in independent claim 1, and as similarly recited in independent claim 15. (emphasis added). Similarly, Wataru does not disclose "canceling prohibition against the inputting of the predetermined operation performed by the operator as the operator guidance if a predetermined time period has elapsed since the prohibition against the inputting of the predetermined operation performed by the operator as the operator guidance," as recited in independent claim 18. (emphasis added).

However, the Office Action asserts that it would have been obvious to substitute an automated switching means for the manual switches (12, 13) of Wataru since it has generally been recognized that the use of conventional control to automate a previously manual operation involves only routine skill in the art (see *In re Venner*, 120 USPQ 193 (CCPA 1958)). This assertion is respectfully traversed.

First, the proposed modification of automating the manual switches (12 and 13) of Wataru would render them unsatisfactory for its intended purpose. "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed

modification." (see *In re Gordon*, 733 F. 2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP §2143.01).

The manual switches 12 and 13 of Wataru detect whether the driver can touch the navigation operation buttons so as to prohibit the driver's operation of the navigation system while driving the car (see Abstract, paragraphs [0006], [0018]-[0021], and [0024] of Wataru). If the driver can operate the manual switches 12 and 13 of Wataru, the driver cannot operate the navigation system. However, by replacing the manual switches 12 and 13 of Wataru with automated buttons, the switches of Wataru would not longer detect when the driver is holding the steering wheel. Thus, the safety feature of the system of Wataru, i.e. prohibiting the driver's operation of the navigation system, would not be achieved.

Because the manual switches 12 and 13 of Wataru provide safety during driving the vehicle by inhibiting the driver's operation of the navigation system, modifying the manual switches to be automated as alleged by the Office Action would render Wataru unsatisfactory for its intended purpose. In fact, Wataru teaches away from such a combination or modification.

Second, the proposed modification would change the principle of operation of the switches of Wataru. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." (see *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) MPEP §2143.01.)

As discussed above, by replacing the manual switches 12 and 13 of Wataru with automated buttons, the buttons of Wataru would not longer detect when the driver is holding the steering wheel (see Abstract, paragraphs [0006], [0018]-[0021], and [0024] of Wataru). Because the safety feature of the system of Wataru, i.e. prohibiting the driver's operation of the navigation system, would not be achieved by automating the manual switches 12 and 13,

modifying the manual switches to be automated as alleged by the Office Action would change the principle of operation of Wataru.

Therefore, a person of ordinary skill in the art would not have been motivated to modify the manual switches 12 and 13 of Wataru to be automated as asserted by the Office Action. Because no motivation exists in Wataru to be modified as alleged by the Office Action, the asserted modification is improper and appears to be based on impermissible hindsight.

Finally, the Office Action improperly relies on *In re Venner* for its motivation for automating the manual switches 12 and 13 of Wataru. MPEP §2144.04 clearly states that "if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court." The court held in *In re Venner* that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art (see MPEP §2144.04 III). However, as discussed above, the Office Action relies on *In re Venner* to assert that it would have been obvious to substitute an automated switching means for the manual switches (12, 13) of Wataru since it has generally been recognized that the use of conventional control to automate a previously manual operation involves only routine skill in the art. *In re Venner* does not support this assertion. The deficiency of Wataru is not similar to the facts in *In re Venner*, and thus the Office Action improperly relies on *In re Venner*.

Further, MPEP §2144.04 clearly states that "if the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection." The operation nullification canceller recited in independent claims 1, 15 and 18 is a critical feature, and thus, *In re Venner* should be relied on as case law to support this obviousness rejection.

Further, Wataru does not disclose an operation nullification device or operation nullification means that "is constructed to judge whether or not the predetermined condition has been fulfilled, depending on the number of dummy switches included in information displayed by the display device," as recited in independent claim 4, and as similarly recited in independent claim 16. Similarly, Wataru does not disclose "judging whether or not a predetermined traveling condition related to operation of the vehicle has been fulfilled, depending on the number dummy switches included in information displayed by the display device," as recited in independent claim 19. Nowhere does Wataru disclose these features.

The Office Action acknowledges on page 13 that Wataru does not specifically teach an operation nullification device or operation nullification means. However, the Office Action alleges that it would have been obvious to utilize a speed sensor (1) and a control device (ECU) of Wataru for the purpose of establishing a relationship between the condition of the car and the images on the display. These assertions are respectfully traversed.

There is no support for utilizing the speed sensor and control device of Wataru to establish a relationship between the condition of the car and the images on display to determine whether a predetermined condition has been fulfilled, depending on the number of dummy switches included in information displayed by the display device. The ECU of Wataru only judges the condition of the car based on the vehicle speed from a speed to determine whether or not to perform the alter operation by touch switches (see paragraph [0015] of Wataru). Thus, the alleged modification of the ECU of Wataru would not judge whether or not a predetermined traveling condition related to operation of the vehicle has been fulfilled, depending on the number of dummy switches included in the information displayed by the display device, as recited in independent claims 4, 16 and 19. Nowhere does Wataru teach or suggest this feature.

Thus, for at least these reasons, independent claims 1, 4, 15, 16, 18 and 19 are patentable over Wataru. Further, claims 2, and 5-7, which variously depend from claims 1 and 4, are also patentable over Wataru for at least the reasons discussed with respect to claims 1 and 4, as well as for the additional features they recite. Withdrawal of the rejection is thus respectfully requested.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachments:

Petition for Extension of Time
Appendix: English translation of Wataru

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